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EXAMINER	
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ART UNIT	PAPER NUMBER
3689	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/731,175	SCHNEIDER, RICHARD J.	
	Examiner	Art Unit	
	THUY VI NGUYEN	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02/03/09*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on 02/03/09, wherein: Claims 1-43 are currently pending; Claims 6, 19, 27, and 41 has been amended; Claims 44-45 have been added.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6-8, 12-22, 32-33, 35-42, 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al (US 6,113,492). Herein after is referred as Walker.

As for claim 1, Walker discloses a method for communicating a report/or data or information concerning a gaming machine's past payout data to a player, comprising:

a) tracking data (about gaming machine payout); [see figures 7 and 9; col. 12, lines 56-65; col. 14, lines 7-14]

b) storing a record of data (payout data) in memory accessible by the gaming machine [...slot machine database (749); col. 13, lines 5-10; lines 45-51; figures 7 and 9]

c) accepting data or information (criteria from a player) [...i.e. *player selects the criteria such as reverse payout mode*; figure 5A, step (506); col. 11, lines 8-32] and

d) communicating to the player the report derived from the record [...display payout information or report f or player viewing; figure 5A, step (510); col. 11, lines 8-32].

Note: for convenience, letters (a)-(d) are added to the beginning of each step.

Note that in step (c), it calls for "a player" which is not limited to the player as shown in the preamble or insteps (a) and (b). In other word, they may not be related and therefore the limitations of steps (a) and (b) do not apply to step (c) since they deal with different player or data.

Note: in step (c), the phrase "*to generate a report ... outcome desired by the player*" is not a positive recited method step but merely intended use of the selected payout data or accepted criteria and thus having no patentable weight. Moreover, the term "*such that particular payout data is selected from the record*" is also not a positive recited method step but merely intended use of the accepted criteria and thus having no patentable weight.

As for claim 2, Walker discloses in which tracking gaming machine payout data comprises tracking winning events [figure 9];

As for claim 3, Walker discloses in which tracking gaming machine payout data comprises tracking the frequency of winning events in a selected time period [col. 9, lines 40-42; col. 17, lines 1-5].

As for claim 4, Walker discloses in which tracking gaming machine payout data comprises tracking particular hand types [...game such as graphical reels or playing cards; col. 5, lines 22-26].

As for claims 6-8, which are objected above since they do not further limit claim 1, basically this deals with the communication the report or information to the player through a display of a gamming machine. This is fairly taught in Walker {see figure 5A step (510) and 7)}.

As for claims 12-14, Walker discloses in which communicating to the player a report at a gamming machine [...figures 5A, and 6 and7]. It is well known in the art that the gamming machine normally have a speaker to audibly inform the player of the result. Therefore, it's assumed that the system of Walker inherently include these features. Therefore, the limitations of dep. claims 12-14 are inherently included in the system of Walker. Moreover, these are not positively claimed, i.e. "is communicated", and are interpreted as "being capable" and the report of Walker is being capable of these communication features.

As for claims 15-16, Which deals with the player communicate to different type of report, e.g. custom report , standard report. This is fairly taught in Walker {see figures 2A-2C, 5B; 8 and col. 11, lines 14-33; col. 14, lines 5-6; e.g. normal payout mode report or information and reverse payout mode report or information.

As for claim 17, Walker discloses in which communicating to the player a report comprises communicating the report to the player before the player enters a game floor [...mailing the players information; col. 14, lines 5-6 and figure 8].

As for claim 18, Walker discloses in which the report is communicated to the player through electronic means [figure 5A]

As for claim 19, Walker discloses in which communicating to the player a report further comprises communicating the report to a plurality of players [...figure 5A].

As for claim 20, Walker discloses in which the report is communicated to a subset of the plurality of players [col. 14, lines 5-6 and figure 8]

As for claim 21, Walker discloses in which the subset of the plurality of players are enrolled in a player tracking system [...col. 14, lines 5-6 and figure 8].

As for claim 22, Walker discloses in which the subset of the plurality of players are players with high player value ratings [see par. 0047, lines 1-6].

As for claim 32, Walker discloses in which the record comprises data corresponding to particular outcomes [col. 1, lines 65-66; figures 2C-3C].

As for claim 33, Walker discloses in which the record comprises data derived from a plurality of gaming machines [col. 12, lines 47-55; figures 2C-3C, 6].

As for claim 43, which deal with the status of the gamming machine, e.g. hot or cold gamming machine., this is fairly taught in Walker {see figure 9, col. 11, lines 10-12, col. 12, lines 18-21}

As for independent claim 35, Walker discloses a method for generating a report of a gamming machine's past payout, comprising:

a) creating a record of payout data [...figures 7 and 9; col. 12, lines 56-65; col. 14, lines 7-14];

b) tracking payout data [...figures 7 and 9; col. 12, lines 56-65; col. 14, lines 7-14];

c) storing tracked payout data in the record [...slot machine database (749); col. 13, lines 5-10; lines 45-51; figures 7 and 9];

d) allowing a player to access a report generator [...figure 5A];

e) accepting criteria from the player such that particular payout data is selected from the record [...i.e. *player selects the criteria such as reverse payout mode*; figure 5A, step (506); col. 11, lines 8-32];

f) generating the report [figure 5A; col. 11, lines 3-33]; and

g) communicating the report to the player [...display payout information or report for player viewing; figure 5A, step (510); col. 11, lines 8-32].

Note: for convenience, letters (a)-(g) are added to the beginning of each step.

Note: in step (e), the phrase "*to generate a report ... outcome desired by the player*" is not a positive recited method step but merely intended use of the selected payout data or accepted criteria and thus having no patentable weight. Moreover, the term "*such that particular payout data is selected from the record*" is also not a positive recited method step but merely intended use of the accepted criteria and thus having no patentable weight.

As for claim 36, Walker discloses in which communicating the report to the player comprises communicating a standard report to the player [...i.e. player select a standard report such as a normal payout mode; figures 2A-2C, 5B; col. 12, lines 12-22].

As for claim 37, Peterson discloses in which communicating the report to the player comprises communicating a custom report to the player [...i.e. player select a standard report such as reverse payout mode; figures 3A-C, 5A; col. 11, lines 14-33].

As for independent claim 38, Walker discloses a system for displaying a gaming machines' historical payout data, comprising;

a gamming machine [figure 1];

memory for storing a record of machine payout data [...figures 1 and 7];

an input device configured to accept criteria from a player such that particular payout data is selected from the record to generate a report derived from the payout data [..Keypad (164) and card reader (166); figure 1, col. 5, lines 13-19; figure 5A]; and

a report generator coupled to the memory and configured to communicate the report to the player [...payout information is generated to display area for player viewing; figures 1 and 5A];

Note: that it appears that independent claim 38 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997*). Apparatus claims cover what a device is, not what a device does. Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. "*such that particular past payout data is selected.....to produce outcome desired by the player*" carries no patentable weight.

As for claim 39, Walker discloses a plurality of gamming machines and a network interconnecting the plurality of gamming machines [figure 6].

As for claim 40, Walker discloses a display [figure 1, display (162)].

As for claim 41, Walker discloses system for displaying the past payout data of a gaming machine, comprising:

a) a plurality of gaming machines, each gaming machine having a display [...display (162); figures 1 and 6]

b) server coupled to the plurality of gaming machines [figures 6 and 7]

c) past play data stored on the server; [figures 6 and 7] and

d) an input device configured to accept criteria from a player [...keypad (164) or card reader (166); figures 1 and 5A], and

f) a processor structured to analyze the past payout data using the criteria input by the player [...figures 1, 5A and 7, user selects the criteria such as reverse payout or normal payout].

Note: that it appears that independent claim 38 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber, 128 F.3d*

1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. "*such that particular past payout data is selected.....to produce outcome desired by the player*" carries no patentable weight.

As for claim 42, Walker discloses an access controller configured to provide access to the past payout data stored on the server to only a player controlled in a player tracking system or to a player with a high player value rating [figures 8-9].

As for claim 44, which discloses the condition of whether a gaming machine is a hot or cold gamming machine, this is taught in Walker {see figure 9, col. 1, lines 26-39; col. 11, lines 10-12, col. 12, lines 18-21}.

As for independent claim 45, basically this claim discloses a computer program product, stored on a processor readable medium, including instructions operable to cause a computer system on a gaming network to perform a similar method of independent claim 1 above. It is rejected for the same reason sets forth the rejected independent claim 1 as indicated above.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims **5, 23-30, 31, 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US 6,113,492) in view of Howington (2002/0152120).

As for claim 5, Walker discloses the invention substantially as claimed as discussed above. Walker further discloses tracking the gaming machine's typical payout data [...figures 6 and 9];

However, Walker does not disclose selecting a time period; and comparing the gamming machine's typical payout data to the machines' payout data for the selected time period.

In similar method of tracking the gamming machine performance , Howington discloses selecting a, time period [see par. 0032, lines 1-8 and figure 5]; and comparing the gaming machine's typical payout data to the machine's payout data for the selected time period [...total wins; see par. 0037, lines 1-10; par. 0039 and figures 7-8].

It would have been obvious to a person of ordinary skill in the art at the time the invention to provide Walker with the operation of gamming device which determine the payouts data to include the comparison the machine payout data as taught by

Howington in order to make the tracking the gamming machine performance more accurately, automatically and efficiently [Howington; par. 0005].

As for claims 23-26, Walker discloses the invention substantially as claimed as discussed above except for the color code feature associated with one or more gaming machines. Howington discloses the report comprises a color code corresponding to the payout data [...different colors depending on their performance; see par. 0044, lines 9-14; par. 0049 and figure 9].

It would have been obvious to a person of ordinary skill in the art at the time the to provide Walker with the operation of gamming device which determine the payouts data to include the method of creating a color code to the payout data as taught by Howington in order to provide the color attraction and the opportunity to customers for selecting which jackpot machine they should play and have a better chance to win.

As for claim 27, Walker discloses the invention substantially as claimed as discussed above. However, Howington discloses further comprising printing a map of the plurality of gaming machines [...map layout; see figures 10-12].

As for claim 28, Walker discloses the invention substantially as claimed as discussed above. However, Howington discloses in which the record comprises data corresponding to a selected time period [see par. 0032, lines 1-8 and figure 5];

As for claim 29, Walker discloses the invention substantially as claimed as discussed above. However, Howington discloses in which the selected time period is an elapsed time between specific payouts [see par. 0018, lines 9-13 and figure 4].

As for claim 30, Walker discloses the invention substantially as claimed as discussed above. However, Howington discloses the selected time period is configured by a user [see par. 0032, lines 1-8 and figure 5];

As for claim 31, Walker discloses the invention substantially as claimed as discussed above. However, Howington discloses in which the record comprises data corresponding to a number of plays between winning events [...figures 5 and 7].

As for claim 34, Walker discloses the invention substantially as claimed as discussed above. However, Howington discloses in which the record is sortable by the frequency of winning events [see figures 2C-3C].

Note: As for claim 23-34, this appears to be a data processing method. The characteristics of the "report" or "information" such as "a color code" data , and the "record" data with are considered to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

6. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US 6,113,492) in view of Benoy et al (2003/0054878). Herein after is referred as Walker and Benoy.

As for claims 9 -11, Walker discloses the invention substantially as claimed as discussed above except for the visual report is printed at the gamming machine and visual report is printed remote from the gamming machine.

In a similar method of displaying information at the gamming machine for the player, Benoy discloses the visual report is printed; and visual report is printed at the gamming machine [... information is printed at gamming machine; see par. 0066, lines 8-12; 0076, lines 15-20 and figure 3A; ... a clerk validation terminal may print out a transaction receipt; see par. 0084, lines 1-4].

It would have been obvious to a person of ordinary skill in the art at the time the invention to provide Walker with displaying the information at the gamming machine for player to view to include the information is printed at the gamming machine as taught by Benoy in order to make a convenient for the player may take the report or information with them once if they don't want to view on the display of a gamming machine. Furthermore, the printing feature is common, old and well known in the art.

Additionally, the characteristics of the "visual report" or "information" or "data" is considered to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. See MPEP 2106.01.

Response to Arguments

7. Applicant's arguments filed on 02/03/09 have been fully considered but they are not persuasive.

Applicant's argument on pages 9-10 regarding to the functional limitation in the claims is noted. However as for claim 1 calls for a method for communicating a report concerning a gaming machine's past pay out data to a player. The method includes (a) tracking gaming machine payout data; (b) storing a record of the payout data in memory accessible by the gaming machine; (c) accepting criteria from a player such that particular payout data is selected from the record to generate a report for the player based on the selected payout data which allows the player to identify a gaming machine from among plurality of gaming machines that is more likely to produce an outcome desired by the player; and (d) communicating to the player the report derived from the record. It is noted that in step (c), it calls for "a player" which is not limited to the player as shown in the preamble or in steps (a) and (b). In other word, they may not be related and therefore the limitations of steps (a) and (b) don not apply to step (c) since they deal with different player or data. Moreover in step (c), the phrase "to generate a report ... outcome desired by the player" is not a positive recited method step but merely intended use of the selected payout data or accepted criteria and thus having no patentable weight. Moreover, the term "such that particular payout data is selected from the record" is also not a positive recited method step but merely intended use of the accepted criteria and thus having no patentable weight.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689